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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,247	06/23/2000	Raanan Liebermann	00-422RE	9739

7590 02/18/2003

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EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 02/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/603,247	Applicant(s) Liebermann
Examiner Stella Woo	Art Unit 2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 1-32 is/are allowed.
- 6)  Claim(s) 33-45 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3      6)  Other:

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## **DETAILED ACTION**

### *Reissue Applications*

1. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

2. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3. Claims 33-45 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).* A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the

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prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During the original prosecution, the examiner issued an Office action, mailed October 1, 1997, rejecting independent claims 1, 12, and 26 based on the prior art references of Kurokawa, Rogers and Abramatic. In a response to the Office action, applicant amended independent claims 1, 12 and 26 by further defining the video apparatus as “visually observing the images of facial and hand and finger signing motions of a deaf person and converting the observed signing motions into digital identifiers,” further defining the means for translating as “translating said digital identifiers of said observed signing motions into words and phrases,” and further defining the means for outputting as “outputting said words and phrases generated by the visual observation of said signing motions in a comprehensible form to another person” (underlining shows added subject matter). The applicant stated that “[t]he independent claims have ...been amended to clarify the unique operation and structure of the present invention. More particularly, each of the independent claims clearly defines the first step of the method or one component of the apparatus as visually observing the facial, finger and hand motion of the deaf person and converting those signing motions into digital identifiers which are then translated into words and phrases.” The applicant specifically argued that “[b]ecause of the technology employed by Applicant in the novel method, the full range of signing motions can be observed, including hand motion, finger motion including interdigitation, body motion, lip motion and

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facial motion... None of the prior art can approach the apparatus and method of the present invention from the standpoint of recognition of all these forms of signing activity.” Therefore, the subject matter previously surrendered in the application for the patent is a system without the following limitations: a video apparatus for visually observing the images of facial and hand and finger signing motions and converting the observed signing motions into digital identifiers, a means for translating said digital identifiers of said observed signing motions into words and phrases, and a means for outputting said words and phrases generated by the visual observation of said signing motions.

The limitations omitted in the newly added claims 33-45 of the reissue are the same limitations added by the applicant for the purpose of obtaining allowance in the original prosecution, as clearly stated in applicant’s arguments during the original prosecution, and applicant is now precluded from recapturing subject matter previously surrendered. The applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection.

***Allowable Subject Matter***

4. Claims 1-32 are allowed because although claims 1-32 were broadened by deleting the “deaf” limitation, the claims 1-32 are broader in an aspect unrelated to a prior art rejection made in the original application. Claims 1-32 recite allowable subject matter because the prior art of

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record do not show or fairly suggest conversion of observed facial, hand and finger motions to digital identifiers which are then translated into words and phrases.

**5. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

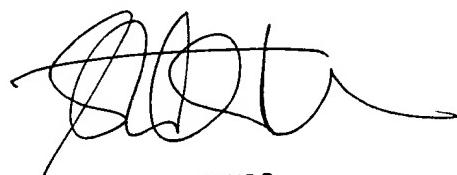
**or faxed to:**

(703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Any general inquiries should be directed to the Customer Service Office at (703) 306-0377.**

February 7, 2003



STELLA WOO  
PRIMARY EXAMINER